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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,784	11/21/2000	Heli Heiskari	944-003.040	8542

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EXAMINER

NGUYEN, LE V

ART UNIT PAPER NUMBER

2174

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,784

Applicant(s)

HEISKARI, HELI

Examiner

Le Nguyen

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

PD

DETAILED ACTION

1. This communication is responsive to an amendment filed 11/29/04.
2. Claims 1-15 are pending in this application. Claims 1, 5 and 9 are independent claims. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Furthermore, the examiner notes that present application 09/717,784 has incorrectly been referred to as "serial no. 09/439,803" on the claim sheets.

Claim Rejections - 35 USC § 103

4. Claims 1, 2, 5, 6, 9, 10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. ("Smith") in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel").

As per claim 1, Smith teaches a computer-readable medium encoded with a data structure for use in providing a graphical icon for display on a display of a portable communications device, characterized in that the data structure is encoded as digital data indicative of the graphical icon defined by alternating light and dark stripes, that a selected stripe of the light and dark stripes changes from light to dark and back to light to indicate a shadow adjacent to an edge of the icon and a selected stripe of the light and dark stripes changes from dark to light and back to dark to indicate a highlight adjacent another edge of the icon, and that altogether the light and dark stripes with

shadows and highlights provide the icon with a three dimensional appearance (fig. 10; col. 7, line 43 through col. 8, line 10; col. 10, lines 64-67; *users may edit the bits of an icon bitmap using an editing-an-icon feature, which includes draw button 1012 and eraser button 1011 for turning on or off each bit of the icon simply by touching each block of icon shown in icon editing screen 1010, in order to create a new icon or modify an existing one so to draw attention to or highlight/emphasize an icon for a three-dimensional appearance, i.e. to have or appear to have extension in depth, such as depicted by icon 1014, an icon having the appearance of depth and a resultant of a combination of light and dark stripes as well as shadows/darkened areas and highlights/emphases*). Although Smith's invention is not limited to the picture of the graphical icon depicted in fig. 10, Smith does not explicitly disclose creating a graphical icon of a selected stripe of said light and dark stripes changes from dark to light *and* remains light in a region bordering on at least a part of a light segment in said neighboring stripe or in a further neighboring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight adjacent to said edge or another edge of said icon.

MS Excel teaches a selected stripe of said light and dark stripes changes from light (fig. 2; *from left to right, column/stripe 32 of the briefcase icon edge*) to dark (fig. 2; *stripe 31*) and remains dark in a region bordering on at least a part of a dark segment of a neighboring stripe (fig. 2; *stripe 30*) and beyond said dark segment said selected stripe remains dark *or* changes back to light to create a shadow adjacent to an edge of said icon (fig. 2; *stripe 29 is the changed light stripe; the whole effect is one of a shadow*

adjacent to the edge of the briefcase icon), and a selected stripe of said light and dark stripes changes from dark (fig. 2; stripe 9) to light (fig. 2; stripe 10) and remains light (fig. 2; stripe 11) in a region bordering on at least a part of a light segment in said neighboring stripe or in a further neighboring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight (fig. 2; stripe 12 is the changed dark stripe; the alternating dark, light, light and dark striped sequence causing a highlight effect) adjacent to said edge or another edge of said icon (figs. 1(A-B) and 2; Smith's method of creating an icon was applied in forming icons 110, 120 and 130 of figs. 1(A-B) and scaled version of 110 and 120 in fig. 2 in order to demonstrate the scope of creating an icon bit by bit or in this instance, cell by cell).

Therefore, it would have been obvious to an artisan at the time of the invention to include MS Excel's teaching of a selected stripe of said light and dark stripes changes from dark to light *and* remains light in a region bordering on at least a part of a light segment in said neighboring stripe or in a further neighboring stripe, and beyond said light segment said selected stripe remains light or changes back to dark to create a highlight adjacent to said edge or another edge of said icon to Smith's teaching of a graphical icon defined by alternating light and dark stripes, that a selected stripe of the light and dark stripes changes from light to dark and back to light to indicate a shadow adjacent to an edge of the icon and a selected stripe of the light and dark stripes changes from dark to light and back to dark to indicate a highlight adjacent another edge of the icon, and that altogether the light and dark stripes with shadows and

highlights provide the icon with a three dimensional appearance as an obvious modification and in order to provide users with a drawing/design choice.

As per claim 2, the modified Smith teaches a computer-readable medium characterized in that the data structure is encoded according to a portable bitmap file format (Smith: col. 7, line 61).

Claims 5 and 9 are individually similar in scope to claim 1 and are therefore rejected under similar rationale.

Claims 6 and 10 are individually similar in scope to claim 2 and are therefore rejected under similar rationale.

As per claim 13, the modified Smith teaches a computer-readable medium wherein the alternating light and dark stripes are vertical (MS Excel: figs. 1(A-B) and 2).

Claims 14 and 15 are individually similar in scope to claim 13 and are therefore rejected under similar rationale.

5. Claims 3, 4, 7, 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. ("Smith", US 5,923,327) in view of Screen Dumps of Microsoft Excel 2000 ("MS Excel") as applied to claims 1, 5 and 9 respectively, and further in view of Hess et al. ("Hess", US 6,415,320 B1).

As per claims 3 and 4, the modified Smith teaches a computer-readable medium characterized in that the data structure is encoded according to a Portable Bitmap file format (col. 7, line 61). Although the modified Smith does not explicitly disclose the file format to be in a Portable Greymap file format or a portable color image file format/Portable Pixmap, Hess teaches a computer-readable medium characterized in

that the data structure is encoded in various file formats, including Portable Bitmap file format, Portable Greymap file format and a Portable Pixmap (col. 8, lines 31-47; *PBM/PGM/PPM*). Therefore, it would have been obvious to an artisan at the time of the invention to include Hess' teaching of a computer-readable medium characterized in that the data structure is encoded in various file formats, including Portable Bitmap file format, Portable Greymap file format and a Portable Pixmap to the modified Smith's teaching of a computer-readable medium characterized in that the data structure is encoded according to a Portable Bitmap file format in order to contribute to the flexibility of saving images in various file formats and providing an additional convenience to the users, especially given that all of these file formats are art equivalents.

Claims 7 and 8 in combination is similar in scope to the combination of claims 3 and 4 and is therefore rejected under similar rationale.

Claims 11 and 12 in combination is similar in scope to the combination of claims 3 and 4 and is therefore rejected under similar rationale.

Response to Arguments

6. Applicant's arguments filed 5/16/05 have been fully considered but they are not persuasive.

Applicant argued the following:

(a) Smith has nothing to do with the present invention, i.e. describing a methodology for designing 3-dimensional icons.

(b) Applicant considers that it is possible to combine Smith et al. and MS Excel to make the present invention obvious; however, the examiner does not show the references quoted containing suggestion or motivation to modify the reference or to combine reference teachings to arrive at the subject matter of claim 1, or to accomplish that without the benefit of hindsight.

The examiner disagrees for the following reasons:

Per (a), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an invention that describes a methodology for designing 3-dimensional icons) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Per (b), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation for the rejection is found in the knowledge generally available to one of ordinary skill in the art, i.e. the knowledge to arrange a collection of dots or lines for a 3-d effect is generally available to one of ordinary skill in the art as an

obvious drawing/design choice.

Moreover, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Inquires

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lê Nguyen whose telephone number is **(571) 272-4068**. The examiner can normally be reached on Monday - Friday from 7:00 am to 3:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax numbers for the organization where this application or proceeding is assigned are as follows:

(703) 872-9306 [Official Communication]

Art Unit: 2174

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

LVN
Patent Examiner
August 4, 2005

Kristine Kincaid
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SUPERVISORY PATENT EXAMINER
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